

Remarks

Claims 1-15, which are in the application stand rejected as being unpatentable under 35 USC 112, first and second paragraphs and further under 35 USC 103(a). The rejections and how they have been overcome or avoided are discussed in the order in which they appear in the Office Action.

35 USC 112, First Paragraph Rejection

Claim 2 stands rejected under 35 USC 112, first paragraph on the grounds that it contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which is most nearly connected, to make and/or use the invention. More specifically the claims are rejected on the grounds that Applicants failed to specify the type of molecular weight (weight average or number average) for the polyisocyanate.

Applicants traverse the rejection because the skilled artisan can in fact ascertain scope and content of the claims. More specifically, the skilled artisan can ascertain the scope and content of the claims relative to the isocyanates based on the NCO content and functionality. Surely, the Examiner would agree that the skilled artisan reading the specification, as a whole would be able to ascertain claim-recited isocyanates. In this regard, Applicants direct the Examiner's attention to page 5, lines 28-29, page 10, lines 24-27, and page 13, lines 4-7 referring to number average molecular weight. In this context, the skilled artisan can readily ascertain the scope and content of the claims.

35 USC 112, Second Paragraph Rejection

Claim 8 stands rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the claim stands rejected because of the term "at one and the same time" and further because of the term desired.

Applicants respectfully submit the term "at one and the same time" as used herein would be clearly understood by the skilled artisan to denote simultaneously. However, Applicants are amenable to considering a term suggested by the Examiner as being acceptable. Similarly, the term "desirable" as used herein would be clearly understood by the skilled artisan to denote optionally. Here as well, Applicants are amenable to considering a term suggested by the Examiner as being acceptable.

35 USC 103(a) Rejection

Claims 1-15 stand rejected under 35 USC 103(a) as being unpatentable over Reiff et al ('370 or '737 or '482) in view of WO 99/52961 on the grounds that:

"The primary references disclose the production of blocked isocyanates and their use with water-proofing and oil-proofing fluorocarbon resins as textile treating compositions, wherein the blocked isocyanates are the reaction product of polyisocyanates including aromatic isocyanates, active hydrogen compounds containing ionic or potential ionic groups, polyoxyalkylene ethers, and blocking agents."

In acknowledging one of the differences between the claims and the cited references, the Examiner correctly noted that:

"Though the primary references disclose several blocking agents, including imidazoles, the reference is silent with respect to the use of pyrazole blocking agents."

Notwithstanding this difference the Examiner rejects the claims on the ground that:

"... pyrazoles were known blocking agents for self dispersible isocyanates, to be used as textile finishes with fluorocarbon polymers, at the time of the invention. This disclosure, in combination with the fact that the disclosed imidazoles of the primary references and pyrazoles are isomers, is considered to render the substitution of pyrazoles for imidazoles of the primary references *prima facie* obvious."

Applicants traverse the rejection because there is no basis in the cited references, which would have led the skilled artisan to substitute pyrazoles for imidazoles with reasonable expectation of success. It is well settled in the law that *prima facie* obviousness must be based on structural similarity and motivation to modify the prior art to the claims, *In re Dillion* 16USPQ2d 1897 (Fed. Cir. 1990).

In this case, the record is devoid of motivation to use pyrazoles instead of imidazoles. Assuming arguendo that pyrazoles are isomers of imidazoles, the inherent difference in properties of compounds having the same composition would not have led to motivation for substitution with a reasonable expectation of success.

Applicants further note that when the invention is considered as a whole, nothing in the secondary references teaches or suggests the specified starting materials:

- (A) one or more aromatic polyisocyanates,
- (B) one or more NCO-reactive compounds containing sulfonate and/or tertiary amino groups,

which are blocked with the pyrazole.

To be sure pyrazoles, as disclosed by the captioned applications, have been used as blocking agents in preparing certain blocked isocyanates for use in paint formulations. However, there is no basis in the art for picking and choosing the claim-recited isocyanates, the NCO-reactive compounds and the blocking agents from the innumerable starting compounds described by the prior art.

Net: Since the cited references lack a basis for selecting and combining the claim recited elements with a reasonable expectation of success, Applicants submit that the claims are patentably distinct over the prior art. Applicants therefore pray for the allowance of the claims. Otherwise, Applicants respectfully request an Examiner's answer in order to advance the prosecution of the application.

Respectfully submitted,

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